Office - Supreme Court, U. S.
FILED
JUN 28 1955
HAROLD B. WILLEY, Clerk

Supreme Court of the United States

October Term, 1955

No. 189

GEORGE WASHINGTON PIERCE,
PETITIONER,

v.

HEWLETT-PACKARD COMPANY and PAUL G. YEWELL, doing business as YEWELL ASSOCIATES, RESPONDENTS.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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GEORGE WASHINGTON PIERCE,
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v.
HEWLETT-PACKARD COMPANY and PAUL G. YEWELL, doing business as YEWELL ASSOCIATES, RESPONDENTS.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

The petitioner, George Washington Pierce, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the First Circuit, entered in the above-entitled case on March 30, 1955.

On May 2, 1955, the Court of Appeals denied a Petition for Rehearing and Motion to Vacate Judgment, Dismiss the Appeal and Remand to the District Court for Further Proceedings. A certified copy is furnished herewith, together with a certified transcript of the record in the above case, including the proceedings in the said Court of Appeals, the latter in compliance with Rule 21 of the rules of this Court.

I.

OPINIONS BELOW

The opinion of the District Court, Judge Wyzanski (A. 63, App. A, *infra*), is reported at 125 F. Supp. 329.

The opinion of the Court of Appeals for the First Circuit (A. 79, App. B), affirming the decision of the District Court, though upon a different ground, is reported at 220 F. 2d 531.

Reference will be made also to an earlier decision of the Court of Appeals for the First Circuit (App. C) *American Communications Company, Inc. v. Pierce*, 208 F. 2d 763, certiorari denied, 347 U. S. 944, rehearing denied, 347 U. S. 970, 348 U. S. 851, reversing the decision of Judge Ford, in the District Court for the District of Massachusetts, *Pierce v. American Communications Company, Inc.*, 111 F. Supp. 181.

II.

JURISDICTION

The judgment of the Court of Appeals was dated and entered March 30, 1955 (R. 84). The Petition for Rehearing and Motion to Vacate Judgment, Dismiss the Appeal and Remand to the District Court for Further Proceedings (R. 84), denied May 2, 1955, a certified copy of which is furnished herewith, will be referred to hereinafter, for brevity, as the Petition for Rehearing.

The jurisdiction of this Court to review the above-mentioned decision of the Court of Appeals is invoked under the provisions of 28 U. S. C., Section 1254(1), (App. E).

Some of the previous decisions of this Court, bearing on jurisdiction, and specifically related to the Questions Presented hereinafter, are as follows:

Question I.

This Court will grant certiorari, even irrespective of other considerations, upon the one ground only that the decision of a Court of Appeals conflicts with principles already firmly established by a prior decision of this Court.

The Ansalddo San Giorgio I v. Rheinstrom Brothers Co., 294 U. S. 494, 496.

National Labor Relations Board v. Newport News Shipbuilding & Drydock Co., 308 U. S. 241, 244.

Ford Motor Co. v. Beauchamp, 308 U. S. 331, 332, rehearing denied, 308 U. S. 640.

West India Oil Co. (Puerto Rico) v. Domenech, 311 U. S. 20, 24, rehearing denied, 311 U. S. 729.

Department of Treasury of Indiana v. Wood Preserving Corporation, 313 U. S. 62, 63.

Spector Motor Service, Inc. v. McLaughlin, Tax Commissioner, 323 U. S. 101, 103.

Girouard v. United States, 328 U. S. 61, 62-63.

This rule applies equally to patent cases where "questions * * * were decided below contrary to our adjudications".

Electric Storage Battery Co. v. Shimadzu, 307 U. S. 5, 8, rehearing denied, 307 U. S. 650.

In the present instance, moreover, the Court of Appeals for the First Circuit has repudiated those established principles, notwithstanding that they have been adopted by the Court of Appeals for the Sixth Circuit.

Questions I and II.

This Court will grant certiorari to construe the patent laws:

Wine Railway Appliance Co. v. Enterprise Railway Equipment Co., 297 U. S. 387.

Sola Electric Co. v. Jefferson Electric Co., 317 U. S. 173, 175.

Halliburton Oil Cementing Co. v. Walker, 329 U. S. 1, 2-3.

United Carbon Co. v. Binney & Smith Co., 317 U. S. 228, 229.

Question III.

The issue raised by Question III is already before this Court, *Bruce A. Mackey v. Sears, Roebuck & Co.*, No. 617, October Term, 1954 and there is pending also at least one further Petition for Certiorari raising that issue, *The Cold Metal Process Company* and *The Union National Bank of Youngstown, Ohio, Trustee v. United Engineering & Foundry Company*, No. 76, October Term, 1955.

III.

QUESTIONS PRESENTED

I. Whether a later patent (2,133,642) for an admittedly important invention may, contrary to land-mark decisions by this Court and the Court of Appeals for the Sixth Circuit, be invalidated for double patenting over an earlier patent (1,789,496) of the same patentee that is held to be invalid for lack of invention, so that the earlier patent is not really a patent, at all, but only a printed publication!

II. Whether the Court of Appeals for the First Circuit has properly construed sections 4(a) and 121 of the new

Patent Act as not applicable to patents issued subsequent to the date of the taking effect of that Act, and whether such construction of the New Patent Act is in conflict with constructions in the Ninth Circuit.

III. Whether the decision of the Court of Appeals for the First Circuit was based upon an appeal from a judgment of the District Court that was not final, under a misconstruction of Rule 54(b) of the Federal Rules of Civil Procedure, contrary to the statutes and also to the construction of these statutes and said Rule by other Courts. Specifically, where suit is entered for infringement, by the same equipment, of a group of patents, and the District Court, under the provisions of Rule 56, enters an order, granting a motion for summary judgment with respect to some only of the claims of one only of the patents, but leaving completely unadjudicated the remaining claims of the said one patent and also all the claims in suit of the remaining patents:

A. Whether the said Rule 54(b) may be construed to authorize an express determination by the District Court that there is no just reason for delay, and the directing of an entry of judgment, thereby to render the said order final and appealable; and

B. Whether the said Rule 54(b), if so construed to render the said order final and appealable, is invalid and void, as contrary to 28 U. S. C., Section 1291.

IV.

STATUTES AND RULES INVOLVED

Questions I and II seek an interpretation of the patent statutes and decisions of this and other courts based thereon.

With respect to the Question II, the pertinent provisions of Title 35, Sections 4(a) and 121 of the Patent Act of 1952,

Public Law 593, 82nd Congress, 2d Session, Chap. 950, 66 Stat. 792, approved July 19, 1952, which took effect on January 1, 1953, together with an extract from the Report from the Committee on the Judiciary of the House of Representatives, 82nd Congress, 2d Session, House Report No. 1923, May 12, 1952, are quoted in Appendix D.

Question III relates to Rules 54(b) and 56(b), quoted in Appendix E.

V.

SUMMARY STATEMENT OF THE MATTERS INVOLVED

Introduction

This is an action for patent infringement, brought by the petitioner. The complaint charges the respondent with manufacturing and selling equipment that infringes each of a group of patents. One of these, the basic patent 2,133,642 (R. 11), issued October 18, 1938, covers a constant-frequency piezoelectric-crystal-controlled oscillator, which has become known to the art as the Pierce oscillator. The remaining patents cover subsidiary piezoelectric-crystal inventions.

The petitioner had originally endeavored to cover all these piezoelectrical inventions by claims in the single basic patent 2,133,642. This, however, the Patent Office would not permit, and ordered division (a term that, though having identically the same meaning, has now been replaced, in the new Patent Act, by the term "a requirement for restriction"). That order for division constituted a holding that the various inventions were distinct and separate.

In compliance with this order for division, the petitioner filed a number of additional applications. One of these additional applications matured, on January 20, 1931, into patent 1,789,496 (R. 35), and accordingly expired on January 20, 1948. The issue of the basic patent 2,133,642 (as well as other patents), however, was delayed in the Patent Office by interference proceedings.

Claim 2 of the said expired patent 1,789,496 covered a combination, namely, a combined radio-transmitting-and-receiving system, provided with two Pierce oscillators (as elements of the combination), one at the transmitting end and the other at the receiving end of the combination. The purpose of providing these two Pierce oscillators was in order that they might interact, to produce constant-frequency beats. (The term "beats", as used in many branches of physics and engineering, will be found defined in any dictionary.)

Particular reference will be made hereinafter to thirteen claims only, namely, claims 51, 52, 54, 55, 56 and 61 to 68, inclusive, of only the one basic patent 2,133,642, covering the Pierce oscillator. Prior to the present litigation, the petitioner was held to be the first inventor of the Pierce oscillator covered by these thirteen claims by three courts: first, the District Court for the District of Delaware, *Miller v. National Broadcasting Company, Inc., Miller v. R. C. A. Communications, Inc.*, 6 F. Supp. 47; secondly, by the Court of Appeals for the Third Circuit, 79 F. 2d 657, affirming this decision of the District Court; and, thirdly, by the Court of Customs and Patent Appeals, *Miller v. Pierce*, 97 F. 2d 141.

In *Pierce v. American Communications Company, Inc.*, 111 F. Supp. 181, *supra*, on motions by both parties for partial summary judgment under the provisions of Rule 56 of the Federal Rules of Civil Procedure, Judge Ford, in the District Court for the District of Massachusetts, went further, and held, not only that the petitioner was the prior inventor of the Pierce oscillator represented by the said thirteen claims, but also that the Pierce oscillator constituted a very valuable invention that was not anticipated by the prior art. Judge Ford held these thirteen claims to be valid and infringed.

On appeal, *American Communications Company, Inc. v. Pierce*, 208 F. 2d 763, *supra*, the Court of Appeals for the First Circuit agreed that the petitioner was the inventor of the Pierce oscillator, and also that the Pierce oscillator is an important invention; describing that invention, page 765 (page 34, *infra*), by such terms, for example, as "plaintiff's distinctive contribution to the art of frequency stabilization" and "a significant improvement over the prior art frequency-controlled oscillating circuits." In this *Hewlett-Packard Company* action, too, the Court of Appeals for the First Circuit termed the Pierce oscillator, page 531 (A80, 28, *infra*) a "distinctive contribution to the 'Progress of Science and Useful Arts', U. S. Const. Art. I, section 8".

In both the *American Communications Company, Inc.* action and this *Hewlett-Packard Company* action, nevertheless, the Court of Appeals for the First Circuit, clearly in the endeavor to "heed the admonition" of this Court, as explained on page 21, *infra*, has found reasons for depriving the petitioner of his property in those thirteen claims.

The two decisions of the Court of Appeals for the First Circuit, in the *American Communications Company, Inc.* action and this *Hewlett-Packard Company* action, however, as will presently appear, were based upon different and self-contradictory legal propositions, neither of which could be sustained.

The Decision of the Court of Appeals for the First Circuit, in American Communications Inc. v. Pierce, 208 F. 2d 763, was Based Upon the Ground, Not of Double Patenting, but Rather Upon the Entirely Different Ground that the Public is Free to Use the Invention of an Expired Patent Even Though, by so Doing, the Public Should Infringe a Valid Basic Unexpired Patent.

The basis of the decision of the Court of Appeals for the First Circuit, in the *American Communications Company, Inc.* action, was that, even though the basic Pierce-oscillator patent 2,133,642 is valid, the petitioner could not be permitted to enforce it against members of the public (including the defendant in that action) who use the precise combination of a combined transmitting-and-receiving system, including two Pierce oscillators as elements of the combination, because that combination was covered by the said claim 2 of the expired combination patent 1,789,496; and, the Court of Appeals held, members of the public are free to use the invention of an expired patent, page 769 (page 41, *infra*):

> With respect to combined transmitting and receiving system utilizing the Pierce oscillator, such as the accused structures, the plaintiff has suffered no hardship because of the delayed issuance of his basic patent No. 2,133,642. The plaintiff by means of patent 1,789,496 has already received the full seventeen years protection granted him by law on such systems. We cannot

now extend the monopoly under the mantle of patent No. 2,133,642.*

In support of this holding, the Court of Appeals for the First Circuit cited *Saranac Automatic Mach. Co. v. Wirebounds Patents Co.*, 1931, 282 U. S. 704, 51 S. Ct. 232, 75 L. Ed. 634.

In the *Saranac* case, however, this Court did not hold that the public may use the invention of an expired patent if, by so doing, the public should infringe a valid basic unexpired patent. The petitioner therefore endeavored to obtain a ruling from this Court as to the soundness of this decision of the Court of Appeals for the First Circuit, in the *American Communications Company, Inc.* action, but certiorari was denied.

The Decision of the Court of Appeals for the First Circuit, in the Present Action, is Based Upon the Entirely Different Ground of Double Patenting.

The petitioner thereupon entered the present suit, in the same District Court for the District of Massachusetts, against a defendant who manufactures and sells Pierce oscillators, and not combined transmitting-and-receiving systems.

In this *Hewlett-Packard Company* action, 220 F. 2d 531, as in the earlier *American Communications Company, Inc.* action, the decision of the Court of Appeals for the First Circuit was based purely upon a question of law.

* The Court of Appeals for the First Circuit even intimated, at the very end of its decision, page 770 (page 42, *infra*) that it would have sustained the basic patent 2,133,642 in an action brought prior to the expiration of the combination patent 1,789,496, distinguishing *Badische Anilin & Soda Fabrik v. A. Klipstein & Co., C. C. S. D. N. Y.*, 1903, 125 F. 543, upon the ground, "unlike the case at bar", of the "non-expiration of the patents in controversy".

The question of law decided by the Court of Appeals for the First Circuit, in this *Hewlett-Packard Company* action, was not, however, the same question of law as that decided in the *American Communications Company, Inc.* action.

In the *American Communications Company, Inc.* action, as before stated, the decision had been that the public has the right to use the invention of an expired patent, even though, by so doing, it may infringe a valid basic unexpired patent.

In the *Hewlett-Packard Company* action, on the other hand, finally realizing that the ground of the decision in the *American Communications Company, Inc.* action was insupportable, in law, the Court of Appeals for the First Circuit based its decision upon the entirely different, though equally insupportable, ground that the basic Pierce oscillator patent 2,133,642 is wholly invalid for double patenting.

SUMMARY OF ARGUMENT IN SUPPORT OF THE ALLOWANCE OF THE WRIT

I. With respect to Question I, the Court of Appeals for the First Circuit has misconstrued the holdings of this Court and other Courts relating to double patenting, to the effect that a second patent to the same patentee for the same invention as that covered by an earlier patent is void for double patenting over that earlier patent, to mean that a later patent may be held invalid, for double patenting, over an earlier patent that never, in fact, was a patent, at all, because invalid, from the very beginning, for lack of invention. So misconstruing those holdings, the Court of Appeals for the First Circuit has now rendered a new

decision that is directly contrary to prior decisions of this Court and the Court of Appeals for the Sixth Circuit.

II. With respect to Question II, the holdings of the Court of Appeals for the First Circuit, in the *Hewlett-Packard Company* action, are contrary to the express provisions of Sections 4 (a) and 121 of the New Patent Act of 1952, and are also in conflict with holdings in the Ninth Circuit.

III. With respect to Question III, the Court of Appeals for the First Circuit was without jurisdiction over the appeal in the *Hewlett-Packard Company* action.

ARGUMENT

Question I

A Later Patent May Not be Held Invalid for Double Patenting Over an Earlier Patent That, Because it is Invalid, is Not a Patent, at All.

The basis of the holding as to double patenting of this Court, in *Miller v. Eagle Manufacturing Company*, 151 U. S. 186, 14 S. Ct. 310, 38 L. Ed. 121, was that, under the law, the Commissioner of Patents was without authority to grant a second patent to the same inventor for the same invention for which he had already granted an earlier patent. The two patents, in that case, covered the same invention, namely, the same identical spring D (shown on the drawings, page 191), though through the medium of claims of different breadth. The holding was that, having obtained

one valid patent, the patentee was not, therefore, entitled to another patent for the same invention.

Under these holdings, there can not, of course, be double patenting except under two conditions: first, the two patents must represent the same invention; and, secondly, the earlier patent must be valid. Neither of these two conditions is to be found, under the reasoning of the Court of Appeals for the First Circuit, in the present suit.

The first condition is not met, because patents 2,133,642 and 1,789,496 clearly do not cover the same invention. Patent 2,133,642, as before stated, covers the Pierce oscillator, a constant-frequency oscillator. Patent 1,789,496, on the other hand, covers a combined transmitting-and-receiving system for producing constant-frequency beats. The invention of a combined transmitting-and-receiving system for producing constant-frequency beats is obviously not the same as the invention of a constant-frequency oscillator. And the Court of Appeals for the First Circuit never made any holding that it is, either in the earlier *American Communications Company, Inc.*, action, or the present *Hewlett-Packard Company* action. In the *American Communications Company, Inc.* action, indeed, at page 769 (page 41, *infra*), the Court of Appeals for the First Circuit refused to make any holding on that point:

> But it is not necessary for the disposition of the present action to decide whether or not the two patents may possibly cover separate inventions.

The second condition is also not met, because, under the holdings of the Court of Appeals for the First Circuit, in this *Hewlett-Packard Company* action, the earlier patent 1,789,496 is invalid. The Court of Appeals for the First

Circuit (evidently inspired by the "heed the admonition" principle, as explained on page 8, *supra* and page 21, *infra*) held that there was no invention in providing two Pierce oscillators, one at the transmitting end and the other at the receiving end of the combined transmitting-and-receiving system, as recited in claim 2 of the expired patent 1,789,496, pages 532-533 (pages 28, 30, *infra*):

> But *there is no element of invention* in the idea * * * In other words, *it is obvious* * * * the inclusion of the plaintiff's piezoelectrical oscillator in a transmitting and receiving system *did not involve any element of perception* (italics supplied).

Since the combination of claim 2 of the expired patent 1,789,496, under these holdings of the Court of Appeals for the First Circuit, did not represent an invention, that expired patent 1,789,496 was invalid, from the very beginning, for want of invention.

This Court has held, from a very early date, *O'Reilly v. Morse*, 15 How. 62, however, that a later patent may not be invalidated for double patenting over an earlier invalid patent. Samuel F. B. Morse, the inventor of the telegraph, obtained two patents, one in 1840 and the other in 1846, the earlier of which he reissued twice and the later of which he reissued once. For present purposes, these may be referred to as the earlier and the later patents, respectively, disregarding the fact that they were reissued. The earlier patent contained eight claims, the first seven of which were held to be valid, and the eighth of which was held to be invalid, because too broad. (In this *Hewlett-Packard Company* decision, similarly, claim 2 only of the plaintiff's expired patent, 1,789,496, has been held, by the Court of Appeals for the First Circuit, to be invalid for lack of invention.) The defendant, in *O'Reilly v. Morse*, *supra*, argued that the second patent was invalid for double pat-

enting, because it claimed the same receiving magnet that was covered also by the earlier patent. As appears from page 122,

> The force of the objection is mainly directed upon the receiving magnet,* which it is said is a part of the machinery of the first patent, and performs the same office.

Mr. Chief Justice Taney, however, held that there could not be double patenting over an earlier invalid patent, page 121:

> It is certainly no objection to this patent, that the improvement is embraced by the eighth claim in the former one. We have already said that this claim is void, and that the former patent covers nothing but the first seven inventions specifically mentioned.

To the same effect is *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 6 Cir., 1898, 80 F. 712, 724. In that case, Judge Taft held that, where two patents are issued to the same inventor, and the earlier patent purports to cover an improvement upon the invention of the later basic patent, either the improvement patent represents an invention different from the basic invention, or else it represents no invention at all. If the improvement patent represents a different invention, Judge Taft added, it is not, of course, the same invention, and the later basic patent can not, therefore, be invalid for double patenting. If, on the other hand, the improvement is not an invention, at all, then, of course, the earlier patent is a nullity, because it covers nothing:

> if they are not inventions, the patents are void, and cover nothing.

A patent that is void, and covers nothing, of course, is not a patent, at all. It is only a publication. And Judge Taft held that such a mere publication can not be used as a

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* Attention may be invited to the analogy between this receiving magnet, claimed in both patents, and the Pierce oscillator of the present case.

basis for invalidating, upon the ground of double patenting, a later basic patent that does cover an invention.

Under the law, as laid down in *O'Reilly v. Morse*, 15 How. 62, 121-122, and *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 6 Cir., 1897, 80 F. 712, 724, therefore, the later patent (2,133,642) can not be held invalid for double patenting over the earlier patent (1,789,496), if assumed to be invalid.

The Court of Appeals for the First Circuit has not cited a single authority, from any court anywhere, to the effect that a later patent may be held invalid for double patenting over an earlier patent that is not a patent, at all, but only a printed publication. The Court of Appeals for the First Circuit, page 533 (p. 29, *infra*) cited *Palmer Pneumatic Tire Co. v. Lozier*, 6 Cir., 1898, 90 F. 732, 744, *Application of Coleman*, 1951, 189 F. 2d 976, 38 C. C. P. A. Patents, 1156 and *Application of Horneman*, 1952, 194 F. 2d 108, 39 C. C. P. A. Patents, 809, but these are not contrary to *O'Reilly v. Morse* and the *Ohio Brass Co.* cases. The *Lozier* case, as a matter of fact, was decided by the same Court of Appeals for the Sixth Circuit that decided the *Ohio Brass Co.* case, two of the same three judges sat in both cases, and the Court went out of its way, pages 744-745, to explain that the two decisions were perfectly consistent. The *Lozier* and also the *Horneman* decisions are discussed more fully on pages 13-15 of the Petition for Rehearing. The *Coleman* decision is no more pertinent.

Question II

The Holdings of the Court of Appeals for the First Circuit Are Contrary, Furthermore, to the Express Provisions of Sections 4(a) and 121 of the New Patent Act of 1952.

As related on pages 6-7, above, the Patent Office held that the *combination* of the transmitter and the receiver, for the purpose of producing constant-frequency beats, constituted an invention distinct and separate from that of the *element* invention (namely, the Pierce-oscillator invention), and accordingly ordered division.

There was a time when an applicant for patent who complied with such an order for division by the Patent Office was in danger of having a court afterwards rule that the later of the two resulting patents was void for double patenting over the earlier of the two patents. During that period, the inventor was between Scylla and Charybdis. If he refused to comply with the requirement for division, he was unable to obtain any patent, at all. If he did comply, on the other hand, there was danger of a Court later holding double patenting.

Judge Bland's solution of the difficulty, *Application of Hirschhorn,* C. C. P. A., 1947, 162 F. 2d 489, 497, that

> The question of course could be settled by legislation,

was, at last, adopted in the new Patent Act of 1952, Sections 121 and 4(a) of which are quoted in Appendix D.

The very purpose of incorporating Section 121 into that new Patent Act was entirely to eliminate the danger of having a court invalidate, for double patenting, the later of several patents issued after an order by the Patent Office for division. This was public policy, expressed by Congress. This Section 121 provides that a patent

(2,133,642) issued on an application in which the Patent Office ordered division, or a patent (1,789,496) issued on the divisional application filed in compliance with this order,

> shall not be used as a reference * * * in the courts against * * * any patent issued on either of them.

Section 4(a) of the Act contains a provision, applicable to patents already issued, as distinguished from applications still on file in the Patent Office:

> Sec. 4(a) This Act shall take effect on January 1, 1953. * * * It shall apply to unexpired patents granted prior to such date except as otherwise provided.

Among the sections "otherwise provided" are those listed in the next-following paragraphs of Section 4; and Section 121 is not among those so listed.

It clearly was not intended by Congress to have a different rule for patents issued prior to the enactment of the Act than for those issued later.

The Court of Appeals for the First Circuit holds that this new law applies to such patents only as were issued subsequently to the taking effect of the new Patent Act, citing, page 533 (page 31, *infra*), *Application of Eisler*, C. C. P. A., 1953, 203 F. 2d 726, 40 C. C. P. A., Patents, 913. The *Eisler* decision, however, covers the case only of applications still on file in the Patent Office at the time of the taking effect of the new Patent Act. Under the provisions of Section 4(a) of the new Patent Act, the benefit of its provisions, including Section 121, is extended to patents already issued (as distinguished from applications still on file) at the date of the taking effect of the new Patent Act.

It is believed also that the decision of the Court of Appeals for the First Circuit, in this case, is contrary to the

rulings of a California District Court, *Riley v. Broadway-Hale Stores, Inc.*, D. C., Cal., 1953, 114 F. Supp. 884, 887, affirmed, 9 Cir., 1954, 217 F. 2d 530, and the Court of Appeals for the Ninth Circuit, *Pacific Contact Laboratories, Inc. v. Solex Laboratories, Inc.*, 9 Cir., 209 F. 2d 529, 533, certiorari denied.

Question III

The Court of Appeals Took Jurisdiction of an Appeal That Was Not Final.

It is believed that Rule 54(b), quoted in Appendix E, has been violated by both the District Court and the Court of Appeals in this action.

In the District Court, before Judge Wyzanski, in this *Hewlett-Packard Company* action, the petitioner protested that this case could not be decided upon motion for partial summary judgment, for two reasons.

One of the reasons, as stated on page 5 of the Petition for Rehearing, was that the motion for partial summary judgment involved only the thirteen claims 51, 52, 54, 55, 56 and 61 to 68 of one only (2,133,642) of a group of patents, all of which were alleged in the complaint to be infringed by the same equipment of the defendant.

This was an issue that the appellant has already once raised, though unsuccessfully, in a Second Petition for Rehearing, *Pierce v. American Communications Company, Inc.*, No. 605, October Term, 1953. Since then, however, this Court has consented to consider substantially the same issue, *Bruce A. Mackey v. Sears, Roebuck & Co.*, No. 617, October Term, 1954, and another petition for certiorari, relating to substantially the same issue is pending, *The*

Cold Metal Process Company and *The Union National Bank of Ohio, Trustee v. United Engineering & Foundry Company*, No. 76, October Term, 1955. In his said Second Petition for Rehearing, the appellant cited the same cases, and explained the same conflict, that are cited and explained in the *Mackey* and the *Cold Metal Process Company* cases. The only difference is that, in the meantime, additional cases have made their appearance, and the conflict has become only the more confused. The most recent cases appear to be *Newburgh Moire Company, Inc. v. Superior Moire Company, Inc.*, 3 Cir., 1954, 218 F. 2d 580, 583, *Steiner v. 20th Century-Fox Film Corporation*, 9 Cir., 220 F. 2d 105 and *United Artists Corporation v. Masterpiece Productions*, 2 Cir., 1955, 221 F. 2d 213.

Under the ruling in *ex parte National Enameling and Stamping Company, Petitioner*, 201 U. S. 156, 160, the question as to whether the apparatus of the defendants is free of infringement of the remaining patents, and even whether it is free of infringement of the remaining claims in suit of even the one patent, will still need to be adjudicated before there can be a final decision upon the petitioner's claim (or cause of action, as it used to be called).

Judge Wyzanski overruled these contentions citing, as his authority, page 331 (page 27, *infra*) the precedent in the *American Communications Company, Inc.* action, *supra*.

It is believed, nevertheless, that, in accordance with the decisions in other jurisdictions, the order granting the motion for partial summary judgment was interlocutory, and not final, and that the Court of Appeals for the First Circuit, therefore, took jurisdiction of the appeal contrary to the statute, U. S. C. 1291.

Any other construction of Rule 54(b), indeed, would appear to raise the question whether this Court had authority to formulate Rule 54(b), within the limitations of 28 U. S. C. 2071 and 2072.

REASONS FOR GRANTING THE WRIT

In the language of Mr. Justice Frankfurter's dissenting opinion, *Jungerson v. Ostby & Barton Co.*, 335 U. S. 560, 568, the decisions of the Court of Appeals for the First Circuit, in this and the *American Communications Company, Inc.* actions,

> raise basic issues regarding the judiciary's role in our existing patent system.

Here is a case where the petitioner made a very important invention in the Pierce oscillator, and another important invention in a combined transmitting-and-receiving system for producing constant-frequency beats, and where the Court of Appeals for the First Circuit admits the importance of at least the Pierce-oscillator invention, yet the petitioner ends up with his two patents both invalidated.

And the reason for this double invalidation appears to be the effort of the Court of Appeals for the First Circuit to conform (in the language of Mr. Justice Jackson, also dissenting in the *Jungerson* action, at page 572) to the

> strong passion in this Court for striking them down so that the only patent that is valid is one which this Court has not been able to get its hands on.

As the Court of Appeals for the Second Circuit expressed it, in the same *Jungerson* action, *Jungerson v. Baden*, 2 Cir., 1948, 166 F. 2d 807, 811, after its attempts to sustain patents had been repeatedly reversed by this Court,

> We should heed the admonition of these reversals.

Congress, on the other hand, does not agree with the Court with respect to its attitude toward patents. Congress has recognized the importance of encouraging invention, particularly in this age, when our very existence as a free and independent nation may depend upon our inventors keeping us ahead of the inventors of hostile nations.* The intention of Congress, to that end, has been made very evident by several very recent legislative enactments.

One of these, for example, is the new Patent Act of 1952. Inventors were becoming discouraged by the administration of the patent laws,** and one of the objects of that new Patent Act was to try to dispel that discouragement. Another example is afforded by the recent tax statute. In that tax statute, Congress has favored inventors, as distinguished from authors and composers, and the Congressional proceedings show that this was done designedly, in order to encourage inventors to invent.

Question I.

It is important to obtain this Court's ruling as to whether, contrary to *O'Reilly v. Morse*, 15 How. 62 and *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 6 Cir., 1898, 80 F.

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* The importance to our defense of the Pierce oscillator was dramatically stated as follows by S. A. Bokovoy, of Federal Telephone and Radio Corporation, in the technical journal of the International Telephone and Telegraph System, Electrical Communications, Volume 21, Number 4, 1944, page 233:

> A quartz crystal oscillator blank is a small, unimpressive looking device which can easily be mistaken for a piece of ground glass, but *it is playing a role in World War II comparable to dive bombers* and block busters (italics supplied).

** The petitioner could tell a tale of his own discouragement. Though his inventions contributed materially to the prosecution of the First World War, and also to that of the Second World War, it is unfortunate that he decided to cease inventing several years before the outbreak of the Second World War. As appears from page 523a of the "Appellant's Apperdix To Brief" in the *American Communications Company, Inc.* action, the date of the last patent application that he filed is May 11, 1935. It is the opinion of his attorneys that our country suffered, in consequence, during the Second World War, bearing heavy losses that, had the petitioner continued to use his inventive faculties, could easily have been avoided.

712, 724 a later patent may now be held invalid, for double patenting over an earlier patent that is invalid for lack of invention and that is not, therefore, a patent at all, but only a printed publication.

Questions I and II.

The proper construction of the new Patent Act, moreover, is of great concern to thousands of patentees whose patents were granted during the seventeen years prior to the date of its taking effect. It is submitted that the intention of Congress, as evidenced by the new Patent Act, that there should no longer be any holdings of invalidity of patents issued as the result of a requirement for division by the Patent Office should be given full force and effect.

To that end, it is important also to resolve the conflict between the Courts of Appeal for the First and Ninth Circuits with respect to the scope of the new Patent Act.

Question III.

It is further important to know just what is the proper construction of Rule 54(b) of the Federal Rules of Civil Procedure. This is an issue that, as before stated, is already before this Court in another Petition for Certiorari, and that is being raised also in at least one additional Petition for Certiorari.

CONCLUSION

For the reasons stated, it is respectfully submitted that this petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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APPENDICES

Appendix A

The Opinion of the District Court

Pierce v. Hewlett-Packard Company et al., D. C. Mass., 125 F. Supp. 329 (reproduced also at R. 63).

WYZANSKI, D. J.

Plaintiff complains of the infringement of six patents, including claims 51, 52, 54, 55, 56, and 61 to 68 inclusive of patent No. 2,133,642. Defendant's answer among other prayers requests that this Court should declare invalid the cited patent.

Plaintiff moved for a preliminary injunction confined to defendant's asserted infringement of the claims just enumerated. He supported the motion by all the evidence he expects to offer in this case with respect to those claims. Defendant moved for a partial summary judgment declaring those claims invalid.

Both parties agree that if the Court of Appeals in *American Communications Co. v. Pierce*, 1st Cir., 208 F. (2d) 763 has adjudicated these enumerated claims void for double patenting, then this Court ought now to grant defendant's motion and deny plaintiff's motion. This is not because of estoppel by judgment—for there is no showing that the present defendant was privy to defendant in the earlier case. It is because this Court has before it all of plaintiff's testimony on the validity of these claims, this testimony corresponds with the testimony in the earlier case, and this Court should apply the principle of *stare decisis*.

What the parties disagree upon is the precise scope of the judgment rendered in the earlier case. Plaintiff contends that the Court of Appeals in the earlier case did not hold that the claims were invalid, but merely held that "patent No. 2,133,642 when read specifically on the accused combined transmitting and receiving systems discloses no invention distinct and separate from that of patent No. 1,789,496." (p. 769). This argument is certainly plausible, but I reject it for the following reasons.

Plaintiff's contention selects a particular phrase from, but ignores the main thrust of, the Court of Appeals' opinion. That opinion, as a whole, shows that the Court ruled that the enumerated claims were invalid for double patenting. At pages 767-768 Judge Hartigan pointed out that in claim 2 of patent No. 1,789,496, issued in 1931, plaintiff had set forth a specific application to "a combined transmitting and receiving system" of the Pierce crystal controlled oscillator used in an electric circuit, and that in the enumerated claims of patent No. 2,133,642, issued seven years later, plaintiff had set forth the same invention in generic form. The learned judge cited and relied upon familiar cases enunciating the doctrine that no valid patent can issue for an invention actually covered by a former patent. (See p. 766, col. 2, and p. 768.)

To accept the interpretation plaintiff places upon the Court of Appeals' opinion would be so inconsistent with other principles of patent law as to be an anomaly. The validity, construction, or limits of a patentee's claim do not depend upon how the claim reads upon the construction of an alleged infringer. This is to turn the issue upside down. For the question of the scope and validity of the patent turn on the contribution and disclosure made by the patentee in the light of prior contributions to and disclosures in the particular art.

Having concluded that I am bound by *stare decisis* to follow the Court of Appeals in holding that the enumerated claims in patent No. 2,133,642 are invalid, I must now consider whether to enter forthwith or temporarily to withhold a formal judgment.

In addition to the enumerated claims in patent No. 2,133,642 other claims in other patents are presented in this case. It would be wasteful of the time of the Court of Appeals, of this Court, and of the parties if I should now confine the evidence in this case to the other 5 patents here in suit, then get reversed with respect to my conclusion relating to patent No. 2,133,642, and thereafter be required to take much of the same evidence with respect to that omitted patent. It is so important to know at once if I have committed error that pursuant to Rule 54(b), I determine that there shall be entered forthwith a final judgment dismissing

plaintiff's claim for relief based upon the enumerated claims of patent No. 2,133,642, and declaring, in response to defendant's first prayer, that the aforesaid patent claims are invalid, void, and unenforceable. At least the declaratory part of this judgment would seem to be appealable. Compare Judge Ford's April 15, 1953 Order for Partial Summary Judgment in *Pierce v. American Communications Company, Inc.*, D. Mass., 111 F. Supp. 181 upon which the Court of Appeals acted in *American Communications Company, Inc. v. Pierce*, 1st Cir. 208 F. (2d) 763.

APPENDIX B

The Opinion of the Court of Appeals for the First Circuit.

Pierce v. Hewlett-Packard Company et al., 1 Cir., 220 F. 2d 531 (reproduced also at R. 79).

HARTIGAN, Circuit Judge.

This is an appeal from an order of the United States District Court for the District of Massachusetts entered October 22, 1954, denying the plaintiff's motion for a preliminary injunction and granting the defendants' motion for partial summary judgment. In his complaint the plaintiff alleged infringement of six patents including claims 51, 52, 54, 55, 56 and 61 to 68 inclusive, of patent No. 2,133,642. The defendants, after the plaintiff moved for a preliminary injunction confined to the defendants' asserted infringement of the above enumerated claims of patent No. 2,133,642, moved for a partial summary judgment declaring those claims invalid. The district court in granting the defendants' motion based its decision on the ground that this Court in American Communications Co. v. Pierce, 1 Cir., 1953, 208 F. 2d 763, certiorari denied, 1954, 347 U. S. 944, 74 S. Ct. 639, 98 L. Ed. 1092, rehearing denied 347 U. S. 970, 74 S. Ct. 775, 98 L. Ed. 1111; had adjudicated these enumerated claims void for double patenting.

The plaintiff bases his appeal in effect on two grounds: (1) that this Court in American Communications Co. v. Pierce, *supra*, did not hold these claims to be invalid for double patenting and (2) that these claims are not invalid for double patenting.

The plaintiff in his construction of our opinion in the American Communications Co. case has, as Judge Wyzanski so aptly phrased it, ignored the main thrust of that opinion.

In our decision we relied on the law set forth in Miller v. Eagle Manufacturing Co., 1894, 151 U. S. 186, 14 S. Ct. 310, 38 L. Ed. 121, and Palmer Pneumatic Tire Co. v. Lozier, 6 Cir., 1898, 90 F. 732. It is not necessary now to repeat the language we cited in the American Communications Co. case from the Miller and Palmer Pneumatic Tire Co. opinions. It is enough to say that we found in the American Communications Co. case that the plaintiff in patents Nos. 1,789,496 and 2,133,642 made only one distinctive contribution to the "Progress of Science and useful Arts," U. S. Const. Art. I § 8, and that was the invention of a two electrode piezo-electric crystal in a single vacuum tube circuit. The utility of this invention was that it obtained to a much greater extent than had been previously possible a constant frequency of oscillations.

The plaintiff now contends that this Court did not understand that the result obtained under his earlier patent No. 1,789,496 was a constant *beat* frequency resulting from the difference in the frequency of oscillations of the receiver and the frequency of oscillations of the transmitter. This beat is comparable to the beat produced when two tuning forks are caused to vibrate at slightly different frequencies, but in place of the tuning forks are two oscillating circuits, one in the transmitter and one in the receiver. But there is no element of invention in the idea that if one employs two circuits each of which produces oscillations at constant or stabilized frequencies the beat resulting from the difference between these two frequencies would be more stabilized and constant than would be the case if each of the circuits produced oscillations at frequencies which could not be fully controlled. In other words, it is obvious that if a transmitter is able to operate at a

constant frequency and the corresponding receiver also operates at a constant frequency that any beat resulting from their combination will also be more constant than would be the case if the receiver or transmitter or both were unable to operate at a constant frequency.

The plaintiff cannot claim that patent No. 1,789,496 is a valid invention merely on the ground that through it a beat is produced for in Kintner v. Atlantic Communication Co., D.C.S.D.N.Y.1917, 241 F. 956, the use of oscillating circuits to obtain a beat was shown to be the subject of a patent antedating the plaintiff's application by almost twenty years. The plaintiff also cannot successfully contend that his earlier patent No. 7,789,496 constitutes a valid invention merely because through the employment of prior art electromechanical vibrators it obtains a more constant beat, for prior to the plaintiff's application for his patent electromechanical vibrators had been used in an attempt to stabilize the frequency of oscillations of an electric circuit. Although these earlier electromechanical vibrators were less efficient than the plaintiff's two electrode piezoelectric crystal in maintaining a constant frequency of oscillations, they did achieve some control over the frequency of oscillations and consequently when employed in transmitting and receiving equipment a more constant beat would be produced than had been possible in circuits not employing such electromechanical vibrators.

[1, 2] The plaintiff received patent No. 1,789,496 only because of his contribution of a device which stabilized the frequency of oscillations of an electric circuit. Without this device the patent would not have been granted. The plaintiff cannot extract this essential element and make it the subject of a subsequent patent. Palmer Pneumatic Tire Co. v. Lozier, *supra*, 90 F. at page 744; see Application of Horneman, 1952, 194 F. 2d 108, 39 C.C.P.A., Patents, 809. The Pierce oscillator, the subject of patent No. 2,133,642 rather than the production of a constant beat, is the essential distinguishing feature of combination patent No. 1,789,496. See Application of Coleman, 1951, 189 F. 2d 976, 38 C.C.P.A., Patents, 1156.

In Palmer v. John E. Brown Mfg. Co., 1 Cir., 1899, 92 F. 925, cited by the plaintiff, the patentee's combina-

tion patent was sustained on the ground that the invention of a quilting machine which was the result of combining the patentee's "mechanical movement", the subject of his basic patent, with a workholder and sewing machine required perception as such combination was not an obvious one. In the instant case, the inclusion of the plaintiff's piezo-electric oscillator in a transmitting and receiving system did not involve any element of perception, as the principal purpose of the oscillator, if not its only purpose, was in the transmission or reception of intelligence my means of high frequency currents.

[3] The plaintiff in 1924 applied for one patent but the Patent Office erroneously required a divisional application with regard to the claims now found in patent No. 1,789,496. The Patent Office thus in effect stated that the plaintiff had two separate inventions, but we are not bound by such a holding and the patent in issue will not be sustained merely because of a requirement of division ordered by the Patent Office.

[4] The plaintiff contends that section 121 of the Patent Act of 1952[1] should be applied by the Court in the instant case and that this statute would prevent the use of the plaintiff's earlier patent as a reference in this case. However, the statute expressly refers to patents "* * * issuing on an application with respect to which a requirement for restriction under this section has been made * * *." The Patent Act of 1952 took

[1] 35 U. S. C.

"§ 121. *Divisional applications*

"If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention."

effect on January 1, 1953. Plaintiff's patent No. 2,133,642 was granted on October 18, 1938. It was, therefore, impossible for the plaintiff's patent to have been issued on an application which was required to be restricted under the 1952 Act and consequently § 121 is inapplicable in the instant case. See Application of Eisler, 1953, 203 F. 2d 726, 40 C.C.P.A., Patents, 913.

The judgment of the district court is affirmed.

APPENDIX C

The Opinion of the Court of Appeals for the First Circuit.

American Communications Co. Inc. v. Pierce, 1 Cir., 208 F. 2d 763, certiorari denied, 347 U. S. 944, rehearing denied, 347 U. S. 970, 348 U. S. 851.

HARTIGAN, Circuit Judge.

This is an appeal from an order of the United States District Court for the District of Massachusetts docketed April 23, 1953, granting plaintiff's motion for partial summary judgment. In his complaint plaintiff alleged infringement of seven patents[1] owned by him, but both parties moved for partial summary judgment under the provisions of Rule 56, F. R. C. P., 28 U. S. C. A. only on claims 51, 52, 54, 55, 56 and 61 to 68 inclusive of the basic patent No. 2,133,642. The district court heard the matter on affidavits, exhibits and documents submitted by both parties. It held that said claims were valid and infringed and granted the plaintiff's motion and denied the defendant's motion.

The application for the basic patent No. 2,133,642 was filed in the Patent Office on February 25, 1924 but because of a subsequent suit[2] brought against two subsidiaries of one of plaintiff's licensees, a Patent Office Interference[3] with one Miller who claimed the same invention as the plaintiff, and divisional rulings by the

[1] No. 2,133,642; No. 2,133,643; No. 2,133,644; No. 2,133,645; No. 2,133,646; No. 2,133,648 and No. 2,266,070.

[2] Miller v. National Broadcasting Co., D. C. Del. 1934, 6 F. Supp. 47, affirmed 3 Cir., 1934, 79 F. 2d 657, rehearing denied Oct. 28, 1935.

[3] Miller v. Pierce, 1938, 97 F. 2d 141, 25 C. C. P. A., Patents, 1195.

Patent Office, the basic patent No. 2,133,642 was not issued until October 18, 1938.

Defendant, American Communications Company, Inc., a Massachusetts corporation, first leased in November, 1949 from Federal Telephone & Radio Corporation certain radio transmitting and receiving equipment. The defendant's use of this equipment in the conduct of its business is alleged to infringe patent No. 2,133,642. Federal Telephone & Radio Corporation, named as a defendant, is a Delaware corporation doing business in New Jersey and is the manufacturer and lessor of the accused radio equipment. It has not been served in Massachusetts and has declined to appear voluntarily in this action.

Patent No. 2,133,642, titled "Electrical System", relates to electrical systems in which a vacuum or radio tube circuit is caused to oscillate. The oscillations produced thereby result in alternating currents of electricity which, when the electrical circuit is designed for transmitting purposes, flow in and out of an antenna thereby producing "carrier" waves. It is important that the frequency of the oscillations of the electrical circuit remains substantially constant. This is particularly true when the oscillating circuit is used for radio broadcasting which the district court found to be the primary importance of the patent in suit. A constant transmitting frequency results in the clearer reception of the carrier waves by a receiver "tuned" to that particular transmitting frequency. Also by decreasing the danger of interference from unstable frequency transmitters, a constant transmitting frequency permits the assignment of a greater number of broadcasting stations. The plaintiff in patent No. 2,133,642 claims a method whereby the frequency of oscillating circuits is rendered constant to an extent unobtainable in the prior art. He asserts that when a two-electrode crystal, with the piezo-electrical properties of executing mechanical vibrations under vibratory electrical stimulus and conversely of developing electrical potentials as a result of its mechanical vibrations, was inserted into a non-oscillating single vacuum tube circuit in place of the prior art "tunable" coils and condensers, the piezo-electric crystal both produced and sustained the frequency of the oscilla-

tions of the circuit at a substantially constant rate, widely independent of the electrical constants of the system.

The defendant in the lower court relied on the defenses of invalidity, non-infringement, double patenting and laches. In holding for the plaintiff the court found no merit in these defenses. In its oral argument before us the defendant stated its willingness to accept the lower court's statement of facts and contended that in view of such facts there is a clear case of double patenting in this action. In that portion of its opinion dealing with the question of double patenting the district court stated: "The original Pierce patent application Serial No. 695,094 was filed on February 25, 1924. It included not only general claims for the use of a piezo-electric crystal to control the frequency of an oscillating system but also (claims 53, 54 and 57) specific claims for the combination of a radio transmitter and receiver in which such crystals could be used. The Patent Office, holding that more than one invention was described in the application, ordered a division. In compliance with this order Pierce, on January 18, 1928, filed several divisional applications. On one of these, Ser. No. 247,469, patent No. 1,789,496 was issued on January 20, 1931. * * *" This divisional patent covered combined transmitting and receiving systems and expired on January 20, 1948, almost two years before the defendant first leased the accused radio equipment from Federal Telephone & Radio Corporation.

In plaintiff's expired patent No. 1,789,496 three claims are specified.[4] Neither claim 1 nor claim 3

[4] 1. A transmitting and receiving system having, in combination, means for transmitting signal waves, means for receiving the signal waves, a local oscillating system comprising an amplifying relay having an inherent regenerative coupling, a source of energy, a piezo-electric body, and means connecting the relay, the source and the body together, the connecting means being such that the local system can not oscillate through the inherent regenerative coupling when the body is disconnected from the system, whereby the frequency of the waves of the local oscillating system is maintained substantially constant, and means for combining the received waves with the local waves.

2. A transmitting and receiving system having, in combination, means for transmitting signal waves, means for receiving the signal waves, each of the said means comprising a source of electric energy, a tube having a plurality of electrodes, an electro-mechanical vibrator having two electric terminals respectively connected with two of the electrodes, means substantially nonperiodically

(Footnote continued on following page.)

reveal the plaintiff's distinctive contribution to the art of frequency stabilization. The plaintiff states in his brief that the prior art piezo-electric-crystal-controlled oscillators shown in the Cady patent No. 1,472,583 may be used as an element in the combined transmitting and receiving system specified in claim 1. Claim 3 is even broader, covering any kind of prior art electro-mechanical vibrator. Claim 2, however, sets forth the plaintiff's distinctive contribution to the art of frequency stabilization in combined transmitting and receiving systems. By specifying the use of a two-electrode electro-mechanical vibrator in a single vacuum tube circuit, which circuit oscillates at a frequency widely independent of the other elements in the circuit and only upon the insertion of the vibrator, the plaintiff claimed a significant improvement over the prior art frequency-controlled oscillating circuits.

The defendant asserts, and we do not understand the plaintiff to deny, that claim 2 of expired patent No. 1,789,496 reads upon the accused structures. The circuit diagrams of the defendant's accused receivers shown in the "Instruction Books for Radio Equipments FT-149-30AZ and FT-145-10A", simplified in plaintiff's exhibit XVIII-B, are, for the purposes of frequency stabilization, substantially the same as the receiver circuit diagrams of Figs. 1 and 3 of patent No. No. 1,789,496. The three-electrode vacuum tube mark-

(Footnote continued from preceding page.)
connecting the source, the tube, and the vibrator together to maintain the vibrator in vibration and the system in oscillation with a frequency widely independent of the electrical constants of the system and determined by a mode of mechanical vibration of the vibrator, the electrical parameters of the system being such that the system will not oscillate in the absence of the vibrator, the terminals being adapted to act conjointly both for electric stimulation and electric response to effect the oscillation of the system, and means for evidencing beats.

3. A transmitting-and-receiving system having, in combination, a transmitting system for transmitting electric waves, an electromechanical vibrator connected with the system for maintaining the frequency of the transmitting system substantially constant, the connections being such as to prevent the operation of the transmitting system at other than the said substantially constant frequency, a receiving system for receiving the electric waves, the receiving system being traversed by local oscillations, and an electromechanical vibrator connected with the receiving system for maintaining the frequency of the local oscillations substantially constant, the connections of the second-named electromechanical vibrator with the receiving system being such as to prevent the local oscillations at other than the second-named substantially constant frequency.

ed V65 in plaintiff's exhibit XVIII-B corresponds to the three-electrode vacuum tubes 124 of Figs. 1 and 3 of patent No. 1,789,496. The piezo-electric crystal Y1 of exhibit XVIII-B corresponds to crystal 2 of Figs. 1 and 3 of patent No. 1,789,496. The condenser C27 in exhibit XVIII-B is merely a conventional output path for the oscillations generated by the circuit and does not affect the operation of the oscillator circuit itself. Condenser C66 and inductance L65 of exhibit XVIII-B represent a parallel tuned resonant circuit in the output circuit of the oscillator and correspond to the inductance coil 40 of Fig. 3 of patent No. 1,789,496. Although there is no condenser shown parallel to the inductance coil 40 of Fig. 3, nevertheless, as is well-known in the art, inherent capacitance is present across the inductance coil 40. The source of electrical energy designated B+ in exhibit XVIII-B produces upon the plate of vacuum tube V65 a positive voltage potential and corresponds to the battery 32 of Figs. 1 and 3. The telephone receiver 42 and the bypass condenser 44 in the plate circuit of Figs. 1 and 3, as the plaintiff states in patent No. 1,789,496 are optional and may be replaced by an inductance, or by the primary winding of a transformer, or by the input terminals of an amplifier, or may be wholly short-circuited. The condenser C69 in the grid-cathode circuit of exhibit XVIII-B is not, as plaintiff's expert Professor Bowles states, essential to the generation of oscillations in the oscillator circuit. The only significant diagrammatic variation in these circuits seems to be in the position of the piezo-electric crystal in the receiver of Fig. 1 of patent No. 1,789,496. The crystal is there placed in the plate-cathode or output circuit, whereas in the other circuit diagrams the crystal is positioned in the grid-cathode or input circuit. However, plaintiff states in his patent No. 1,789,496, p. 1, lines 85-94 inclusive:

> "The electromechanical vibrator, shown as a piezo-electric body 2, is differently disposed in the different diagrams, so as to illustrate a few of the many different ways in which the vibrator may

be employed. It is to be understood, however, that the vibrator disposition, in a particular diagram, is not specific to that diagram, but that the vibrator may be similarly disposed in the other diagrams. * * * "

Also by a similar comparison of the transmitting circuits of radio equipments FT-149-30AZ and FT-145-10A, simplified in plaintiff's exhibits XIX-B and XX-B respectively, with the transmitting circuit of Fig. 1 of patent No. 1,789,496, it will be seen that the circuits are, in all material aspects, substantially identical.

[1] Plaintiff contends, however, that claims 51, 52, 54, 55, 56 and 61 to 68 inclusive of the unexpired patent No. 2,133,642 also read upon the accused structures. He must show, therefore, that, in relation to the accused structures, patent No. 2,133,642 was granted for a distinct and separate invention from that of expired patent No. 1,789,496, for, as was stated in Miller v. Eagle Manufacturing Co., 1893, 151 U. S. 186, 198, 14 S. Ct. 310, 315, 38 L. Ed. 121:

"The result of the foregoing and other authorities is that no patent can issue for an invention actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ; that the second patent, although containing a broader claim, more generical in its character than the specific claims contained in the prior patent, is also void; but that where the second patent covers matter described in the prior patent, essentially distinct and separable from the invention covered thereby and claims made thereunder, its validity may be sustained.

"In the last class of cases it must distinctly appear that the invention covered by the later patent was a separate invention, distinctly different and independent from that covered by the first patent; in other words, it must be something substantially different from that comprehended in the first patent. It must consist in something more than a mere distinction of the breadth or scope of the claims of each

patent. If the case comes within the first or second of the above classes, the second patent is absolutely void. * * * "

Assuming that claims 51, 52, 54, 55, 56 and 61 to 68 inclusive of patent No. 2,133,642 read upon the accused structures, we do not understand how, with respect to the accused structures, these claims of patent No. 2,133,642 may be said to be a distinct and separate invention from that of claim 2 of expired patent No. 1,789,496.

Plaintiff admits that the transmitter portion of the combined transmitting and receiving system of Fig. 1 of patent No. 1,789,496 is substantially the same as the transmitter illustrated by Fig. 7 of the plaintiff's basic patent No. 2,133,642 and that the receiver portion of Fig. 1 is the same as the receiver illustrated by Fig. 8 of the plaintiff's patent No. 2,133,642. Plaintiff further admits that the modified transmitting system shown in Fig. 2 of the combination patent No. 1,789,496 is substantially a reproduction of Fig. 9 of the plaintiff's patent No. 2,133,642. To indicate the similarity between claim 2 of patent No. 1,789,496 and the allegedly infringed claims of patent No. 2,133,642 we have compared in the margin[5] the elements of claim 2 of patent No. 1,789,496 with a representative claim such

[5]

Claim 2 of expired patent No. 1,789,496	Claim 67 of basic patent No. 2,133,642
A transmitting and receiving system having, in combination, means for transmitting signal waves, means for receiving the signal waves, each of said means comprising a source of electric energy,	A generating system
	of constant frequency oscillations
a tube having a plurality of electrodes,	comprising a vacuum tube,
an electro-mechanical vibrator	a piezo-electrical element of hard, durable material
having two electric terminals respectively connected with two of the electrodes.	provided with a single pair of operative electrodes in circuit with said tube,
means substantially non-periodically connecting the source, the tube, and the vibrator together	
	and a resonant circuit in the output of said tube carrying oscillating currents

(Footnote continued on following page.)

as claim 67 of patent No. 2,133,462. Claim 2 of patent No. 1,789,496 states the use of an electro-mechanical vibrator, but the succeeding elements of the claim reveal that such a vibrator corresponds with the piezo-electrical element specified in claim 67 of patent No. 2,133,642. It seems to us that the only significant difference indicated in the respective claims of the two patents is the use to which the piezo-electrical body may be put. Claim 2 of patent No. 1,789,496 narrows the operation of the piezo-electric crystal to a combined transmitting and receiving system. Claim 67 of patent No. 2,133,642 more broadly states its use in "a generating system." But when the generic "generating system" of claim 67 is read so as to apply to the accused combination transmitting and receiving structures in suit, then patent No. 2,133,642 claims nothing that is separate and distinct from claim 2 of patent No. 1,789,496.

The plaintiff claimed in patent No. 1,789,496 an improved means for frequency stabilization in combined transmitting and receiving systems. He did not claim to be the first to produce a combined transmitting and receiving system as such. It was the use of the plaintiff's two-electrode piezo-electric crystal in the combination, and not the combination itself, which constituted the "essential distinguishing feature" of patent No. 1,789,496. Application of Coleman, 1951, 189 F. 2d 976, 979, 38 C. C. P. A., Patents, 1156. Thus, what we said in Otis Elevator Co. v. Portland Co., 1 Cir., 1903, 127 F. 557, 562, applies with equal force here: " • • • Bassett did not, in his first patent, reserve what he now

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(Footnote continued from preceding page.)

to maintain the vibrator in vibration and the system in oscillation with a frequency widely independent of the electrical constants of the system and determined by a mode of mechanical vibration of the vibrator,

the electrical parameters of the system being such that the system will not oscillate in the absence of the vibrator,

the terminals being adapted to act conjointly both for electric stimulation and electric response to effect the oscillation of the system, and means for evidencing beats.

having a frequency determined at all times by a natural period of mechanical vibration of said piezo-electric element,

said piezo-electric element constituting an essential element in the system for the generation of oscillations.

terms his generic invention. By patenting a specific machine as an embodiment of his generic invention, and not because of any distinct invention involved in specific and patentable features, he patented the subject-matter of the claims of the patent in suit. * * * "

Plaintiff attempts to find a distinction between the two patents with relation to the accused structures in the specification of patent No. 1,789,496 which states: "The superposed frequency may also be used to supply a carrier wave in a radio telephone system where the system operates by suppressed carriers," and from the affidavit of plaintiff's expert, Professor Bowles, who states: "In one system of radio transmission, a much more efficient transmission can be achieved if one of the components of the transmitted wave, known as the 'carrier' can be 'suppressed', that is, not transmitted. This leaves its power to be applied to increase the energy of that part of the signal which is transmitted. The reception of such a signal requires that oscillations of exactly this carrier frequency be supplied independently at the receiver. If the said frequency is not precisely right the signal is garbled. The Pierce patent 1,789,496 solves his problem." Plaintiff argues that this problem could not be solved by merely controlling a transmitter alone or a receiver alone as claimed in patent No. 2,133,642. But plaintiff in his brief admits this was only one "particular additional problem," and we believe its solution to be an incidental and auxiliary result to the solution of the main problem for which the plaintiff was granted patent No. 1,789,496 namely, improved frequency stabilization of oscillations in a combination transmitting and receiving system by the use of a two-electrode piezo-electric crystal in a single vacuum tube circuit.

[2] Plaintiff further attempts to distinguish the two patents on the grounds that under claim 1 of patent No. 1,789,496 the prior art piezo-electric crystal of Professor Cady, and under claim 3 any kind of electro-mechanical vibrator, may be used in the combined transmitting and receiving system. Even if such a construction of claims 1 and 3 of patent No. 1,789,496 is a correct one, (which seems doubtful in view of the spec-

ifications, particularly pages 3 and 4 of the patent, and the diagrams none of which show anything that resembles a Cady oscillating circuit), nevertheless, the distinctive contribution of the plaintiff to the art of frequency stabilization in a combined transmitting and receiving system was embodied in claim 2 of patent No. 1,789,496. Cady's prior art circuits shown in Figs. 1, 3 and 4 of his patent No. 1,472,583, plaintiff admits, stabilized the frequency of the oscillations of the circuit over a very narrow range of variation of the other electrical elements of the circuit and oscillated even upon removal of the piezo-electric crystal from the circuit. The oscillating circuit specified in claim 2 of patent No. 1,789,496, on the other hand, maintained a frequency widely independent of any variation in the other electrical elements of the circuit and only oscillated upon insertion of the piezo-electric crystal. Also Cady's circuit shown in Fig. 2 of his patent No. 1,472,583 required three vacuum tubes to produce and control oscillations and, plaintiff admits, was only an effective stabilizer at low frequencies because of the necessity of a piezo-electric crystal with four electrodes. The oscillating circuit specified in claim 2 of patent No. 1,789,496 required only a single tube and, since only a two-electrode piezo-electric crystal was needed, stabilized both low and high frequencies. Plaintiff himself states that the oscillator circuit of claim 2 of patent No. 1,789,496 is the "preferred" element in a combined transmitting and receiving system. Plaintiff here seems to be attempting to disclaim his distinctive improvements over the prior art which made his application patentable. The use of any kind of electro-mechanical vibrator under claim 3 of patent No. 1,789,496 or of a prior art Cady piezo-electric oscillating circuit under claim 1 in a combined transmitting and receiving system was not the "dominating new result" contributed by the plaintiff to the art of frequency stabilization of such combinations. Saranac Automatic Mach. Co. v. Wirebounds Patents Co., 1931, 282 U. S. 704, 51 S. Ct. 232, 75 L. Ed. 634. The plaintiff in so construing the claims of his patent No. 1,789,496 ignores their patentable features. However,

as stated in Palmer Pneumatic Tire Co. v. Lozier, 6 Cir., 1898, 90 F. 732, 744: " * * * One cannot extract an essential element of his invention from a former patent, without which the former patent would not have been granted, and make it the subject of a subsequent patent. * * * " See also Miller v. Eagle Manufacturing Co., *supra*, and Otis Elevator Co. v. Portland Co., *supra*.

[3] Plaintiff further argues that the Patent Office Examiner in ordering a division of plaintiff's original application, ruled that the invention of patent No. 2,133,642 and that of patent No. 1,789,496 to be two separate and distinct inventions, and that such a ruling by the Patent Office Examiner as stated in *In re* Cady, 1935, 77 F. 2d 106, 109, 22 C. C. P. A., Patents, 1190, 1195 "should not be lightly overruled." But it is not necessary for the disposition of the present action for us to decide whether or not the two patents may possibly cover separate inventions. We only hold that the generic patent No. 2,133,642 when read specifically on the accused combined transmitting and receiving systems discloses no invention distinct and separate from that of patent No. 1,789,496.

With respect to combined transmitting and receiving systems utilizing the Pierce oscillator, such as the accused structures, the plaintiff has suffered no hardship because of the delayed issuance of his basic patent No. 2,133,642. The plaintiff by means of patent No. 1,789,496 has already received the full seventeen years protection granted him by law on such systems. We cannot now extend that monopoly under the mantle of patent No. 2,133,642. Saranac Automatic Mach. Co. v. Wirebounds Patents Co., *supra*.

The cases relied upon by the plaintiff are distinguishable in that, unlike the case at bar, they involved either the earlier issued divisional patent being an improvement on the later issued patent, Thomson-Houston Electric Co. v. Ohio Brass Co., 6 Cir., 1897, 80 F. 712, or the patents covering separate and distinct inventions, In re Carlton, 1935, 77 F. 2d 363, 22 C.C.P.A., Patents, 1223; General Electric Co. v. P. R. Mallory & Co., 2 Cir., 1924, 298 F. 579 or the non-expiration of

the patents in controversy, Badische Anilin & Soda Fabrik v. A. Klipstein & Co., C.C.S.D.N.Y. 1903, 125 F. 543.

The judgment of the District Court is vacated and the case is remanded to that court for entry of judgment for defendant. Defendant recovers costs on appeal.

APPENDIX D

The New Patent Act.

Section 121 of the New Patent Act.

Section 121 of Title 35, The Patent Act of 1952, United States Code, Public Law 593, 82nd Congress, 2nd Session, Chap. 950, 66 Stat. 792, approved July 19, 1952, which took effect January 1, 1953, reads as follows:

> Sec. 121. Divisional applications. If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

Report from the Committee.

The Report from the Committee On the Judiciary of the House of Representatives, 82nd Congress, 2nd Session, House Report No. 1923, May 12, 1952, describes Section 121 as follows, page 20:

Section 121. New Section.

> This section enacts as law existing practice with respect to division, at the same time introducing a number of changes. Division is made discretionary with the Commissioner. The requirements of section 120 are made applicable and neither of the resulting patents can be held invalid over the other merely because of their being divided in several patents. In some cases a divisional application may be filed by the assignee.

Section 4(a) of the New Patent Act.

Section 4 (a) of the Patent Act of 1952 reads as follows:

> This Act shall take effect on January 1, 1953 and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

APPENDIX E

Other Statutes and Federal Rules of Civil Procedure

28 U. S. C., Section 1254 (1).

Cases in the Courts of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree.

28 U. S. C., Section 1291. Final Decisions of District Courts.

The courts of appeals shall have jurisdiction of appeals from all final decisions of the district courts of the United States, the District Court for the Territory of Alaska, the United States District Court for the District of the Canal Zone, the District Court of Guam, and the District Court of the Virgin Islands, except where a direct review may be had in the Supreme Court. *As amended Oct. 31, 1951, c. 655, § 48, 65 Stat. 726.*

28 U. S. C., Section 2071. Rule-making Power Generally.

The Supreme Court and all courts established by Act of Congress may from time to time prescribe rules for the conduct of their business. Such rules shall be consistent with Acts of Congress and rules of practice and procedure prescribed by the Supreme Court. *As amended May 24, 1949, c. 139, § 102, 63 Stat. 104.*

28 U. S. C., Section 2072. Rules of Civil Procedure for District Courts.

The Supreme Court shall have the power to prescribe, by general rules, the forms of process, writs, pleadings, and

motions, and the practice and procedure of the district courts of the United States and of the District Court for the Territory of Alaska in civil actions.

Such rules shall not abridge, enlarge or modify any substantive right and shall preserve the right of trial by jury as at common law and as declared by the Seventh Amendment to the Constitution.

Such rules shall not take effect until they have been reported to Congress by the Chief Justice at or after the beginning of a regular session thereof but not later than the first day of May, and until the expiration of ninety days after they have been thus reported.

All laws in conflict with such rules shall be of no further force or effect after such rules have taken effect. Nothing in this title anything therein to the contrary notwithstanding, shall in any way limit, supersede, or repeal any such rules heretofore prescribed by the Supreme Court. *As amended May 24, 1949, c. 139, § 103, 63 Stat. 104; July 18, 1949, c. 343, § 2, 63 Stat. 446; May 10, 1950, c. 174, § 2, 64 Stat. 158.*

Rule 54(b).

(b) JUDGMENT UPON MULTIPLE CLAIMS. When more than one claim for relief is presented in an action, whether as a claim, counterclaim, cross-claim, or third-party claim, the court may direct the entry of a final judgment upon one or more but less than all of the claims only upon an express determination that there is no just reason for delay and upon an express direction for the entry of judgment. In the absence of such determination and direction, any order or other form of decision, however designated, which adjudicates less than all the claims shall not terminate the

action as to any of the claims, and the order or other form of decision is subject to revision at any time before the entry of judgment adjudicating all the claims.

Rule 56(b).

(b) FOR DEFENDING PARTY. A party against whom a claim, counterclaim, or cross-claim is asserted or a declaratory judgment is sought may, at any time, move with or without supporting affidavits for a summary judgment in his favor as to all or any part thereof.

FILED
JUL 23 1955
HAROLD B. WILLEY, Clerk

Supreme Court of the United States.

OCTOBER TERM, 1955.

No. 189.

GEORGE WASHINGTON PIERCE,
Petitioner,

v.

HEWLETT-PACKARD COMPANY AND PAUL G. YEWELL, DOING BUSINESS AS YEWELL ASSOCIATES,
Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Supreme Court of the United States.

OCTOBER TERM, 1955.

No. 189.

GEORGE WASHINGTON PIERCE,
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HEWLETT-PACKARD COMPANY AND PAUL G. YEWELL, DOING BUSINESS AS YEWELL ASSOCIATES,
Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

Preliminary Statement.

The Court of Appeals for the First Circuit and the District Court, following and upon the authority of an earlier decision of the same Court of Appeals in the *American Communications* case* on the same patent and claims, refused petitioner (plaintiff below) a preliminary injunction and granted respondents' motion for summary judgment, declaring invalid, and dismissing the complaint insofar as it related to, certain claims† (hereinafter referred to as "the

*American Communications Co., Inc., v. Pierce, 208 F. (2d) 763; cert. den. 347 U.S. 944; rehearing den. 347 U.S. 970, 348 U.S. 851.

†Claims Nos. 51, 52, 54, 55, 56 and 61 to 68 of Patent No. 2,133,642.

claims") of one of petitioner's patents in suit, No. 2,133,642 (hereinafter referred to as the "later patent"). The basis of the decision was that the claims were invalid for double patenting as claiming no different invention from that claimed in petitioner's earlier, expired patent No. 1,789,496 (hereinafter referred to as the "earlier patent"). Petitioner here seeks, in effect, a rehearing of the denial of his petition for *certiorari* in the *American Communications* case and has evolved elaborate and completely untenable arguments (1) that the Court of Appeals' decision conflicts with the established law as to double patenting, (2) that the Patent Act of 1952 has been misconstrued, and (3) that an important question of jurisdiction of the Court of Appeals to hear petitioner's own appeal has been raised under Rule 54(b) of the Federal Rules of Civil Procedure.

It will be shown that every contention of petitioner is without merit and no important reason exists why the Court should take jurisdiction in this case.

The points urged by petitioner in the petition will be discussed in the order in which the petitioner presented them.

Argument.

As to Question I (Petition, pp. 12-16).

The Court of Appeals in Nowise Held Invalid the Earlier Patent — the Later Claims were Held Invalid for Double Patenting because they Claimed the Same Invention as Claims of the Earlier Patent.

In the petition (pp. 12-16) petitioner argues, first, that the Court of Appeals, contrary to its previous decision, held the earlier patent invalid for lack of invention over the prior art, and, second, that it held invalid the claims of the later patent for double patenting over the earlier, allegedly

void, patent, which therefore is "only a publication."* How petitioner arrives at this extraordinary conclusion from reading the opinion of the Court of Appeals is beyond our understanding. Counsel for petitioner attempted to make this very argument orally before the Court of Appeals, and his error was promptly pointed out from the bench. Here he has repeated it. As a matter of fact, the court merely held (220 F. (2d) 531, 532-533; Petition, p. 29):

> "The plaintiff received [the earlier] patent No. 1,789,496 only because of his contribution of the device which stabilized the frequency of oscillations of an electric circuit. Without this device the patent would not have been granted. *The plaintiff cannot extract this essential element and make it the subject of a subsequent patent.*† Palmer Pneumatic Tire Co. v. Lozier, supra, 90 F. at page 744; see Application of Horneman, 1952, 194 F. 2d 108, 39 C.C.P.A., Patents, 809. The Pierce oscillator, the subject of [the later] patent No. 2,133,642 rather than the production of a constant beat, is the essential distinguishing feature of [the earlier] combination patent No. 1,789,496. See Application of Coleman, 1951, 189 F. 2d 976, 38 C.C.P.A., Patents, 1156."

What the court was saying was that there was but a single invention present if any. This was the Pierce oscillator. This oscillator was claimed one way, more narrowly, in the claims of the earlier patent, and therefore could not be claimed another way, by itself, or broadly, in the claims of the later patent. A single invention cannot be made the subject of claims in both an earlier and a subsequent patent to the same patentee, for this would result in an unlawful

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*Petition, p. 15.

†Emphasis added throughout this brief unless otherwise indicated.

extension of the patent monopoly, in this case a very profitable monopoly indeed,* which petitioner has already enjoyed to the full seventeen years. The decision was fully in accord with all the classic cases on the subject which were relied upon by the court.

The court below further stated that this was the true holding of its prior decision in the *American Communications* case. The holding is in accordance with fundamental principles of American patent law, and no decision of this Court can be found in conflict therewith. Since the court *did not* hold the earlier patent invalid, petitioner's entire argument on Question I is directed to an imagined, not a real, situation and there is in this case no such question as Question I for this Court to consider. Construing petitioner's Question I as challenging the actual holding of double patenting for twice claiming the same invention, then the same is merely a request for rehearing of the denial of the petition in the *American Communications* case without a proper showing under Rule 58 of this Court.

As to Question II (Petition, pp. 17-19).

Section 121 of the New Patent Act of 1952 (1) on Its Face Is Inapplicable to Patents Granted Prior to January 1, 1953; And (2) Does Not Purport to Change the Rule of Law that Two Patents to the Same Person on a Single Invention Cannot Both be Valid.

The applicable provisions of the new Patent Act are quoted in Appendix D to the petition. Petitioner's contention that the decision below was in conflict with § 121 of the Patent Act of 1952 was fully argued by him in his previous

*Petitioner has collected in the neighborhood of one million dollars in royalties for the use of his invention (see p. 3, Petition for Certiorari in *Pierce* v. *American Communications Co.*, October Term, 1953, No. 605).

unsuccessful petition to this Court.* In effect, petitioner now seeks a rehearing of his previous petition on this point.

Petitioner contends that the court below improperly used petitioner's earlier patent "as a reference" in holding invalid for double patenting the claims of the later patent. The court below carefully pointed out (220 F. (2d) 531, 533; Petition, pp. 30-31):

> "the statute expressly refers to patents '* * * issuing on an application with respect to which a requirement for restriction under this section has been made * * *.' The Patent Act of 1952 took effect on January 1, 1953. Plaintiff's patent No. 2,133,642 was granted on October 18, 1938. It was, therefore, impossible for the plaintiff's patent to have been issued on an application which was required to be restricted under the 1952 Act and consequently §121 is inapplicable in the instant case. See Application of Eisler, 1953, 203 F. 2d 726, 40 C.C.P.A., Patents, 913."

It is urged by petitioner that the last sentence of § 4 (a)† (Petition, p. 43), which reads: "It [the Act] shall apply to unexpired patents granted prior to such date [the effective date of the Act] *except as otherwise provided,*" means that § 121 must apply to all unexpired patents, since § 121 is not listed in the next following paragraphs of § 4 of the Act (Petition, p. 18).

It would seem to respondent that nothing could be plainer than the fact that in § 121 itself it is so *"otherwise provided."* This section on its very face states that a patent may not be used as a reference if it issues "on an application with respect to which a requirement for restriction *under this section* has been made. . . ." The section did

Pierce v. *American Communications Co., Inc.*, October Term, 1953, No. 605, pp. 47-51 of that petition.

†Act of July 19, 1952, c. 950, 66 Stat. 815.

not exist when the requirement for division was made in the Patent Office as to the application resulting in the patents in suit. Nor was there any similar statute in existence. No reason is seen why the "otherwise provided" language should be taken as limited to the specific sections enumerated in the paragraphs following § 4 (a) of the Act.

Be that as it may, it is clear that Congress had no intention to change the law as to double patenting by enacting § 121 of the new Act. The law as laid down in *Miller* v. *Eagle*• is written into § 121; its first requirement is "if two or more *independent and distinct inventions* are claimed . . ." There can be little doubt, therefore, that courts would hold unenforceable or invalid a second patent of the same patentee claiming an invention which was not independent and distinct from the invention claimed in his earlier patent, whether the second patent were tested by the new or the old Patent Act.

Petitioner has attempted to distinguish (Petition, p. 18) *Application of Eisler,* 203 F. (2d) 726 (C.C.P.A. 1953), 40 C.C.P.A., Patents, 913, on the grounds that the Court of Customs and Patent Appeals in that case was dealing with applications still pending in the Patent Office on the effective date of the new Act. But the *Eisler* case would seem to apply *a fortiori* to the present case, for its reasoning is even more compelling as applied to an already issued patent as compared to a still pending application which remains subject to corrective amendment or division in the Patent Office.

In what respect the decision of the Court of Appeals in this case is contrary to decisions in the District Court in California and the Ninth Circuit as alleged by petitioner (Petition, p. 19) is not seen. In the case of *Riley* v. *Broadway-Hale Stores, Inc.,* 114 F. Supp. 884, 887 (D.C. Cal. 1953); affd. 217 F. (2d) 530 (C.A. 9th, 1954), the Court of

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•*Miller* v. *Eagle Manufacturing Co.,* 151 U.S. 186, 196-199.

Appeals for the Ninth Circuit specifically found (footnote, p. 531) that it was not necessary to decide whether the Patent Act of 1952 applied to the case before it, since § 251 of the new Act was a re-enactment of pre-existing law. *Pacific Contact Laboratories, Inc.*, v. *Solex Laboratories, Inc.*, 209 F. (2d) 529, 533 (C.A. 9th, 1953); cert. den. 348 U.S. 816, applied § 103 of the Patent Act to unexpired patents issued before January 1, 1953. How this has any bearing upon § 121 of the Act is not apparent.

As to Question III (Petition, pp. 19-21).

The Court of Appeals Had Jurisdiction of the Appeal on Independent Grounds Whether or Not There Was a Final Judgment Within the Special Meaning of Rule 54(b).

Having lost his own appeal, petitioner urged below in his unsuccessful "Petition for Rehearing and Motion to Vacate Judgment, Dismiss the Appeal and Remand to the District Court for Further Proceedings" and now again urges that the Court of Appeals had no jurisdiction to hear his appeal. He apparently contends (Petition, pp. 19-21) that the sole basis for the jurisdiction of the Court of Appeals was the inclusion in the judgment (R. pp. 65-66) of the "talismanic language"* prescribed by Rule 54(b). Petitioner completely overlooks the well-established jurisdiction of the Court of Appeals to review the refusal of a preliminary injunction under 28 U.S.C. § 1292(1) (quoted in annexed Appendix A, *infra*, p. 11).† Since the Court of Appeals

*See petition in *Sears, Roebuck & Co.* v. *Mackey*, October Term, 1954, No. 617 (cert. granted).

†The declaration of invalidity under 28 U.S.C. § 2201 (Appendix A, *infra*, p. 11), would seem by the plain language of the statute also to be clearly appealable. As Judge Wyzanski said in the present case (R. p. 65): "At least the declaratory part of this judgment would seem appealable." But see *Petrol Corporation* v. *Petroleum Heat & Power Co.*, 162 F. (2d) 327 (C.A. 2d, 1947).

plainly had jurisdiction of the cause wholly independently of the applicability, validity or proper interpretation of Rule 54(b) or of 28 U.S.C. § 2201, this is hardly a case for this Court to review for the purpose of determining the legality or effect of that rule and the statute.

Conceivably, petitioner is under the impression that his appeal was not from an order denying a preliminary injunction. While Judge Wyzanski did not in the portions of his order immediately following the formalized expressions, "ORDERED, ADJUDGED AND DECREED" refer in so many words to the motion for preliminary injunction, it is perfectly clear that the order was one denying a preliminary injunction. Judge Wyzanski said in his opinion dated October 22, 1954 (R. p. 63):

> "Plaintiff moved for a preliminary injunction confined to defendant's asserted infringement of the claims just enumerated. He supported the motion by all the evidence he expects to offer in this case with respect to those claims. Defendant moved for a partial summary judgment declaring those claims invalid."

He further said in his "Partial Summary Judgment," also dated October 22, 1954 (R. p. 65):

> "This cause having come on to be heard on plaintiff's motion for a preliminary injunction and on defendants' motion for partial summary judgment and the cause having been argued by counsel and the Court in an Opinion filed October 22, 1954, has denied the plaintiff's motion for a preliminary injunction. . . ."

That the Court of Appeals had before it an appeal from a denial of preliminary injunction was conceded by petitioner and accepted by the court, as is evidenced by the quotations from petitioner's briefs and from the opinion of the court set out in Appendix B hereto, *infra*, p. 11.

Even absent the petitioner's formal motion for preliminary injunction, which was heard and denied, it is well established that the order of the District Court "that the Complaint be, and hereby is, dismissed in so far as it relates to [the claims] . . ." where the complaint sought (R. pp. 8-9) "preliminary and final injunctions against further infringement by the defendants and those controlled by the defendants . . ." constitutes a refusal of an injunction within § 1292 giving the Court of Appeals jurisdiction of the appeal.* *A fortiori* there is appellate jurisdiction to review an order denying a formal motion for preliminary injunction. Also, of course, it is well established that, when a cause is properly before an appellate court, it may rule on validity of patent claims *sua sponte,* even if (unlike the present case) this question has not been decided by the court below and even if neither party has argued it or pleaded with respect to it.†

Conclusion.

Petitioner's contention as to Question I rests upon a misconstruction of the opinion below. Such misconstruction is plain from the face of the opinion. The opinion raises no such question as Question I which petitioner seeks to have reviewed.

Petitioner's Question II is the same as already considered and refused review by this Court in the previous petition for certiorari in the *American Communications* case. No intervening circumstances of substantial or controlling effect or

*See *Bendix Aviation Corp.* v. *Glass,* 195 F. (2d) 267, 277 (C.A. 3d, 1952).

†See *Slawson* v. *Grand Street R.R. Co.,* 107 U.S. 649 (1882); *Magic City Kennel Club* v. *Smith,* 38 F. (2d) 170 (C.C.A. 10th, 1930); affd. 282 U.S. 784; *Jones* v. *Cyphers,* 126 F. 753 (C.C.A. 2d, 1903).

other substantial grounds are stated to support what is, in substance, a petition for rehearing on this question (see Rule 58 of this Court).

Petitioner's Question III, challenging the jurisdiction of the Court of Appeals to hear petitioner's own appeal, collapses in view of the fact that the Court of Appeals had jurisdiction of the case on grounds wholly independent of either Rule 54(b) or 28 U.S.C. § 2201, *i.e.*, to review the refusal of an injunction. Further, this Court is warranted as a matter "of sound judicial discretion"* in withholding review from a litigant who, having lost his appeal, now, by challenging the validity of his own act, seeks a second bite—to have the Court of Appeals' decision nullified and start over again.

For the foregoing reasons, the petition is without merit and should be denied.

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APPENDIX A.

28 U.S.C. § 1292. *Interlocutory decisions.*

The courts of appeals shall have jurisdiction of appeals from:

(1) Interlocutory orders of the district courts of the United States, the District Court for the Territory of Alaska, the United States District Court for the District of the Canal Zone, the District Court of Guam, and the District Court of the Virgin Islands, or of the judges thereof, granting, continuing, modifying, refusing or dissolving injunctions, or refusing to dissolve or modify injunctions, except where a direct review may be had in the Supreme Court (as amended Oct. 31, 1951, c. 655, § 49, 65 Stat. 726).

28 U.S.C. § 2201. *Creation of Remedy.*

In a case of actual controversy within its jurisdiction, except with respect to Federal taxes, any court of the United States, upon the filing of an appropriate pleading, may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought. Any such declaration shall have the force and effect of a final judgment or decree and shall be reviewable as such. (As amended May 24, 1949, c. 139, § 111, 63 Stat. 105.)

APPENDIX B.

Opening sentence of opinion of Court of Appeals, 220 F. (2d) 531 (Petition, p. 27):

> "This is an appeal from an order of the United States District Court for the District of Massachusetts

entered October 22, 1954, denying the plaintiff's motion for a preliminary injunction and granting the defendants' motion for partial summary judgment."

Concluding sentence, p. 79, main brief of petitioner in the Court of Appeals:

"It is therefore respectfully submitted that the judgment of the District Court should be vacated, and that the District Court should be directed to enter judgment denying the motion of the defendants for partial summary judgment and granting the plaintiff's motion for preliminary injunction."

Portion of concluding sentence of petitioner's reply brief, Court of Appeals, p. 19:

". . . that the plaintiff's motion for a preliminary injunction should be granted."

Opening paragraph, petitioner's "Memorandum in Opposition to the Appellees' Motion to Limit the Contents of the Record on Appeal":

"This appeal is from an order of the District Court for the District of Massachusetts granting a motion by the defendants-appellees for partial summary judgment and denying a motion by the plaintiff-appellant for the issuance of a preliminary injunction accompanied by an affidavit of Edward L. Bowles."

Office - Supreme Court, U. S.
FILED
SEP 15 1955
HAROLD B. WILLEY, Clerk

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PETITIONER'S REPLY BRIEF

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PETITIONER'S REPLY BRIEF

The petitioner has presented three questions:

I. Whether a later patent to the same inventor may be held invalid for double patenting over an earlier patent that is itself held to be invalid for lack of invention;

II. Whether the Court of Appeals for the First Circuit has properly construed the new Patent Act; and

III. Whether the District Court could render a non-final decision final, merely by invoking Rule 54(b) of the Federal Rules of Civil Procedure.

The respondent replies as follows:

I. The respondent agrees that the answer to the first question is in the negative, but argues that the Court of Appeals did not hold the earlier patent invalid;

II. The respondent argues that the Court of Appeals did properly construe the new Patent Act; and

III. The respondent agrees that the answer to the third question is in the negative, but argues that the Court of Appeals did not take appellate jurisdiction over a non-final decision, under the provisions of Rule 54(b), but, rather, that the Court of Appeals took appellate jurisdiction over an interlocutory order, under the provisions of 28 U. S. C., 1292 (1).

I.

The Court of Appeals Did Hold the Earlier Patent Invalid.

Quotations from the decision of the Court of Appeals, holding that the combination covered by the earlier patent 1,789,496 lacked invention, are given at the upper half of page 14 of the Petition for Certiorari. Two of these quotations, for example, read that (unlike the Pierce oscillator covered by the later basic element patent 2,133,642, which, as stated on page 8, second paragraph, of the Petition of Certiorari, the Court of Appeals has twice held to constitute a very important invention) the combination of the earlier patent (R. 81-82)

"did not involve any element of perception"

and that

"there is no element of invention in the idea".

A combination (namely, the combined transmitting-and-receiving system, with two Pierce piezoelectric oscillators, each for producing *oscillations* of constant frequency, as two elements of the combination, for the purpose of producing *beats* of constant frequency) that lacks "any element of perception", and in which "there is no element of

invention", of course, is admittedly invalid for lack of invention.*

II.

There is a Conflict of Opinion as to the Proper Construction of the New Patent Act.

The new Patent Act was enacted for the purpose of encouraging invention (page 22 of the Petition for Certiorari). It should therefore be liberally construed.

And it *was* liberally construed, by Judge Learned Hand, speaking for the Court of Appeals for the Second Circuit, as recently as June 20, 1955, *Lyon v. Bausch & Lomb Optical Co.*, 106 U. S. P. Q. 1, rehearing granted in part, denied in part, 106 U. S. P. Q. 240. In that decision, Judge Learned Hand held that it was the intention of Congress, through the medium of the new Patent Act, to put an end to the "stricter test of invention" that has been applied by this Court during the last "twenty, or perhaps, twenty-five years before the Act of 1952 went into effect on January 1, 1953," and to restore the test of invention "to the accepted standards of that time."

On page 5, the respondents quote from the decision of the Court of Appeals for the First Circuit, construing the new Patent Act as without retroactivity. Judge Learned Hand, however, was of a different opinion:**

> but § 4(a) leaves no possibility of doubt as to that it is to "apply to unexpired patents granted prior to such date" January 1, 1953 "except as otherwise provided"; and all that was "otherwise provided" was in § 4(e): * * * As a matter of construction § 4(e)

* Three further arguments of the respondents bearing on this topic are refuted in the Appendix.

** Judge Learned Hand was discussing a different section of the Patent Act, but the reasoning is the same.

> seems to us conclusive; it preserves any "finding" of a court before January 1, 1953; but leaves the court free thereafter to apply the Act as though it had existed when the unexpired patent issued.

Though it is quite true, as the respondents say, at the bottom of page 5 and the top of page 6, that section 121

> did not exist when the requirement for division was made in the Patent Office,

nevertheless, as appears from the Report from the Committee, page 43 of the Petition for Certiorari:

> This section enacts as law *existing practice* with respect to division (italics supplied),

and "requirement for restriction" is merely another name for "requirement for division", *Application of Ferguson*, 41 C. C. P. A. (Patents), 1953, 208 F. 2d 366 (see the footnote, page 370, line 1.)

The respondents are further in error in the statement, at the top of page 6, that

> Congress had no intention to change the law as to double patenting by enacting § 121 of the new Act.

On the contrary, Congress had every intention of correcting the evils pointed out by Judge Bland, as explained on page 17 of the Petition for Certiorari.

The petitioner can answer similarly all the other arguments of the respondents, but it would take too much space here to do so.

The Courts of Appeals for the Second and Ninth Circuits are not in agreement with the Court of Appeals for the First Circuit as to how the new Patent Act should be construed. The petitioner asks only that the parties be permitted to argue and brief fully their respective points of view, in order that this Court may make a final and authoritative decision as to the proper construction of the new Patent Act.

III.

The Court of Appeals Did Take Appellate Jurisdiction Over a Non-Final Decision, Under the Provisions of Rule 54(b) of the Federal Rules of Civil Procedure.

This Court distinguishes between opinions and judgments. *Commissioner of Internal Revenue v. Estate of Bedford,* 325 U. S. 283, 287. *In United States v. Hark,* 320 U. S. 531, 534-535, this Court went further, and said:

> Where, as here, a formal judgment is signed by the judge, this is *prima facie* the decision or judgment rather than a statement in an opinion or a docket entry.*

As stated in *Williamson v. Chicago Mill & Lumber Corporation,* 8 Cir., 1932, 59 F. 2d 918, 919, therefore, "* * * the opinion of the court can in no way be treated as a decree * * *"; and an opinion, as distinguished from a judgment, accordingly, "is not before us on this review", *Micromatic Hone Corporation v. Mid-West Abrasive Co.,* 6 Cir., 1949, 177 F. 2d 934, 938.

The petitioner accordingly appealed to the Court of Appeals, not from the *opinion* of the District Court, but from its *judgment.* That judgment (R. 66), however, did not purport to deny the petitioner's motion for preliminary injunction. This the opinion itself (as well as the judgment) makes very clear (R. 65):

> I determine that there shall be entered forthwith a final judgment *dismissing plaintiff's claim for relief* based upon the enumerated claims of patent No.

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* This was accompanied by the following footnote 7.

In the federal courts an opinion is not a part of the record proper, *England v. Gebhardt,* 112 U. S. 502, 506; and in some jurisdictions the docket entries are not.

To quote from *England v. Gebhardt,* 112 U. S. 502, 506:

Neither is the opinion of the court a part of the record. Our Rule 8, sec. 2, requires a copy of any opinion that is filed in a cause to be annexed to and transmitted with the record, on a writ of error or an appeal to this court, but that of itself does not make it a part of the record below.

> 2,133,642, and declaring, in response to defendant's first prayer, that the aforesaid patent claims are invalid, void and unenforceable (italics supplied).

That judgment, therefore, expressly *dismissed the complaint* (insofar as it related to the claims involved in the respondents' motion for summary judgment), and ignored completely the motion for preliminary injunction.*

In support of the holding that this judgment is appealable, the District Court (R. 65) cited the precedent of the *American Communications Company, Inc.* decision. Unless this Court takes jurisdiction, on the present Petition for Certiorari, therefore, that case will continue to be a precedent for piece-meal appeals.

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* The respondents criticize the petitioner for first appealing from the decision of the District Court, and now arguing that the decision of the District Court was not appealable.

But what choice did the petitioner have? The District Court overruled the petitioner's contention that its judgment would not be appealable, and refused to grant the appellant a trial, until after first learning, from the Court of Appeals "at once if I have committed error" (R. 65).

By appealing, under the circumstances, the petitioner did not waive his contention as to jurisdiction. The question of jurisdiction may be raised at any time. *Chicago, Burlington and Quincy Railway Company v. Willard*, 220 U. S. 413, 419. *United States v. United States Fidelity & Guaranty Co.*, 309 U. S. 506, 513.

CONCLUSION.

On pages 21-23, the Petition for Certiorari asks this Court to decide:

I. "basic issues regarding the judiciary's role in our existing patent system";

II. whether the will of Congress to encourage invention shall be thwarted by the courts; and

III. the proper construction of Rule 54 (b) of the Federal Rules of Civil Procedure.

It is therefore respectfully submitted that this Court should grant the Petition for Certiorari.

Respectfully submitted,

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APPENDIX.

It has been demonstrated, on page 14 of the Petition for Certiorari and on page 2, *supra*, that the Court of Appeals has held that:

First, the earlier combination patent 1,789,496 is invalid for lack of invention; and

Secondly, the later element patent 2,133,642 is invalid for double patenting over the earlier invalid combination patent.

This disposes of the argument of the respondents that the Court of Appeals did *not* hold the earlier patent 1,789,496 invalid.

It may be desirable, however, to refute three further arguments of the respondents.

1.

It is quite true that, as the respondents point out, page 3, the Court of Appeals held also:

> The plaintiff can not extract this essential element [the Pierce oscillator] and make it the subject of a subsequent patent.

Why not, if the earlier patent is not a patent, at all, because invalid, and is accordingly only a publication?

The Court of Appeals supported its holding relating to the extracting of an "essential element" by reference to *Palmer Pneumatic Tire Co. v. Lozier*, 6 Cir., 1898, 90 F. 732, 744 (R. 82). In that case, however, the Court of Appeals for the Sixth Circuit held the later patent invalid for double patenting over an earlier *valid* patent. There was double patenting because the earlier patent was *valid*.

The decision of the Court of Appeals in the present case is directly contrary to that of this Court in *O'Reilly v. Morse,* 15 How. 62. In that case, as explained on pages 14-16 of the Petition for Certiorari, it was similarly contended, in effect, that the receiving magnet was an "essential element" of the inventions claimed in both patents. But this Court, contrary to the holding of the Court of Appeals in the instant case, held *the earlier patent invalid* and *the later patent, therefore, valid.*

The decision of the Court of Appeals can not be reconciled with even its own previous decision, *Palmer v. John E. Brown Mfg. Co.,* 1 Cir., 1899, 92 F. 925, attempted to be distinguished by the Court of Appeals (R. 82). The "mechanical movement" of the element patent there involved was certainly an "essential element" of the quilting-machine combination of which it was an element. The Court of Appeals nevertheless *held both patents valid.*

If the combination of the combined transmitting-and-receiving system of patent 1,789,496, similarly, *had* been regarded by the Court of Appeals as involving "any element of perception", or as having any "element of invention", therefore, the Court of Appeals would similarly have held this earlier combination patent 1,789,496 to be valid, instead of invalid; and, so holding the earlier combination patent 7,789,496 to be valid, the Court of Appeals would similarly have held the later element patent 2,133,642 also valid.

2.

The Court of Appeals held that the earlier combination patent 1,789,496 was *invalid.* The Court of Appeals did *not* hold, as the respondents say, at the bottom af page 3

FILED
OCT 4 195
HAROLD B. WILLEY,

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SUPPLEMENT TO PETITIONER'S REPLY BRIEF

The petitioner would invite this Court's attention to several developments subsequent to the preparation of the Petitioner's Reply Brief.

A.

On page 3 of that Reply Brief, in connection with the question as to the proper construction of the new Patent Act, reference was made to a decision by Judge Learned Hand, dated June 20, 1955, construing the new Patent Act liberally. Whether Judge Hand was correct in that liberal construction is now presented to this Court by Question 1, page 3, of a recently filed Petition For A Writ of Certiorari, *Bausch & Lomb Optical Co.* v. *Dean A. Lyon.*

B.

On page 20 of the petitioner's Petition For A Writ of Certiorari, reference was made to a number of additional decisions further illustrating the struggles of the various Courts of Appeals to arrive at a correct understanding of the meaning of Rule 54(b) of the Federal Rules of Civil Procedure. The Federal Reporter of September 12, 1955, contains a decision of the Court of Appeals for the Second Circuit, *Rieser* v. *The Baltimore and Ohio Railroad Company*, 2 Cir., 1955, 224 F. 2d 198, in which Judge Clark, at page 204, holds that *Flegenheimer* v. *General Mills*, 2 Cir., 191 F. 2d 237, previously decided by a different panel of the same Court of Appeals for the Second Circuit, "cannot be taken as the present law of this Circuit", and Judge Frank, pages 205-206, though "reluctantly" concurring, protests nevertheless that "I still think correct the views there expressed" in the *Flegenheimer* decision, which were "carefully thought out", and "where the opinion was by our wisest and most experienced living judge, Learned Hand".

Though other jurisdictions have not since been heard from, the *Flegenheimer* decision is still regarded as good law in at least the District of Columbia, *Capital Transit Co.* v. *District of Columbia*, 21 Fed. Rules. Serv. 54b.4, Case 7.

The present case will not necessarily be governed by what this Court may decide in *Sears, Roebuck and Co.* v. *Mackey*, No. 34, October Term, 1955. In the present case, part only of the single unitary "claim" (or cause of action) has been adjudicated: several claims only of a number of claims in suit of the same patent have been held invalid, and it will be necessary later to adjudicate further the remaining claims, with additional appeals from such

further adjudication. In the words of Judge Clark, however, page 199, "* * * an entire claim must be adjudicated and appeals cannot be taken from an order upon a part of a single claim." See also *United States* v. *Florian*, 312 U. S. 656, *Leonard* v. *Socony-Vacuum Oil Co.*, 7 Cir., 1942, 130 F. 2d 535, 536, *Munson Lime, Inc.* v. *Green*, 2 Cir., 1948, 165 F. 2d 321 and *ex parte National Enameling and Stamping Company, Petitioner*, 201 U. S. 156, 160.

This same issue is raised in another Petition For A Writ of Certiorari, *Pierce* v. *American Communications Company, Inc.*, No. 295, October Term, 1955.

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